

DISPUTE RESOLUTION SERVICE

D00018404

Decision of Independent Expert

Norcis Ltd

and

Susan Roebuck

1. The Parties:

Complainant: Norcis Ltd
Cleveleys
Selby Road
Monk Fryston
Leeds
North Yorkshire
LS25 5JE
United Kingdom

Respondent: Miss Susan Roebuck
Twiss Bank
16 Mill Lane
Ingleton
North Yorkshire
LA6 3GJ
United Kingdom

2. The Domain Name:

norcis.co.uk

3. Procedural History:

I confirm that I am independent of each of the parties. To the best of my knowledge and belief, there are no facts or circumstances, past or present, or that could arise in the foreseeable future, that need be disclosed as they might be of such a nature as to call in to question my independence in the eyes of one or both of the parties.

18 January 2017 13:44 Dispute received
19 January 2017 10:55 Complaint validated
19 January 2017 10:59 Notification of complaint sent to parties
06 February 2017 14:14 Response received
06 February 2017 14:14 Notification of response sent to parties
09 February 2017 01:30 Reply reminder sent
10 February 2017 10:46 Reply received
10 February 2017 10:47 Notification of reply sent to parties
22 February 2017 15:42 Mediator appointed
22 February 2017 17:22 Mediation started
08 March 2017 17:20 Mediation failed
10 March 2017 15:04 Close of mediation documents sent
10 March 2017 15:04 Expert decision payment received

4. Factual Background

- 4.1** The Complainant is an English limited company called Norcis Ltd which provides engineering related services to clients in the water, chemical and defence sectors.
- 4.2** The Complainant was incorporated as a limited company on 20 February 2008. It has traded as Norcis Ltd for approximately the last 9 years.
- 4.3** NORCIS is an acronym for Northern Control and Instrumentation Solutions which broadly describes the Complainant's business.
- 4.4** The Domain Name was registered by the Respondent on 25 February 2008. It has always been used by the Complainant both to point to the Complainant's website at www.norcis.co.uk and in e-mail addresses for the Complainant and its staff.
- 4.5** The Complainant is owned by Paul Woodhouse and his wife Beth Woodhouse. Beth Woodhouse's maiden name is Wigglesworth and the Respondent is the partner of Mr Peter Wigglesworth who is Beth Woodhouse's father.
- 4.6** Apart from the most recent renewal which the Respondent has paid for and not been reimbursed the registration of the Domain Name and renewals of the Domain Name were paid for by the Respondent, but reimbursed by the Complainant.

- 4.7 The Respondent has acted as an administrator for the Domain Name and at various times the Respondent has offered to transfer the Domain Name to the Complainant.
- 4.8 There is an ongoing family dispute which has led to a falling out between Mr and Mrs Woodhouse and Mrs Woodhouse's father, Mr Peter Wigglesworth. This has led to communication breaking down between the Respondent and the Complainant.

5. Parties' Contentions

Complainant's Submission

Rights

- 5.1 NORCIS is the name of the Complainant. It was incorporated at Companies House on 20 February 2008 and continues as a viable concern.
- 5.2 The Complainant has filed accounts at Companies House for the last 9 years and the Domain Name is used in the e-mail addresses of the Complainant and appears on all the correspondence, orders, invoices, etc of the Complainant.

Abusive Registration

- 5.3 The Respondent is the partner of the father of one of the owners of the Complainant. She purchased the Domain Name on behalf of the Complainant at around the time of the incorporation of the Complainant. The Complainant says that the Respondent unintentionally registered the Domain Name in her own name and e-mail address instead of the name of the Complainant as was intended.
- 5.4 The Respondent registered the Domain Name because of the prior relationship between the Respondent and the Complainant, i.e. because of the family relationship and because the Respondent is a computer lecturer and therefore computer literate.
- 5.5 The Domain Name has been used solely by the Complainant and has not been used by the Respondent, whose only involvement has been to renew the Domain Name from time to time. The costs of renewing the Domain Name have been reimbursed by the Complainant.
- 5.6 As a result of a family rift, communication between the Complainant and the Respondent has broken down and the Respondent has refused to transfer the Domain Name to the Complainant.

Respondent's Submission

- 5.7** The Respondent is the registered owner of the Domain name and that registration will continue in her name for a period of three years. She has paid for that and the Complainant has not.
- 5.8** The Respondent has sought no alterations to the contents of the Complainant's website, has not sought to take down the website and has not sought to sell the Domain Name to the Complainant or anyone else. Her registration of the Domain Name is not an Abusive Registration under the terms of the Policy and the Complaint is not in compliance with the Policy.
- 5.9** The ownership of the Domain Name was on offer from at least 2011 and in 2014 she gave Mr Woodhouse (on behalf of the Complainant) all user names and passwords to help to arrange a transfer of the Domain Name, but he did nothing to effect that transfer despite being reminded twice in 2015.
- 5.10** Further, because of the deplorable behaviour of Mrs Woodhouse (one of the owners of the Complainant) towards the Respondent's partner (Mrs Woodhouse's father) and his mother, the Respondent took back control of the Domain Name in April 2016.
- 5.11** Communication between the Respondent and the Complainant has broken down and she has been extremely upset and hurt by the actions of the owners of the Complainant, Mr and Mrs Woodhouse.
- 5.12** It is nonsense that the Domain Name was unintentionally registered in her name.

Complainant's Submissions in Reply

- 5.13** The Complainant's Reply is in two halves. The first half largely repeats the points that are made in the Complaint and these can be briefly summarised as follows:
- There is no dispute that the Respondent originally registered the Domain Name on behalf of the Complainant;
 - The Respondent is a computer teacher and very computer literate and therefore offered to assist the Complainant in the set-up of the Domain Name. This was done with the intention of the Domain Name being owned by the Complainant;
 - There is no dispute that the Respondent has sought to alter the contents of the Complainant's website or that the Respondent has ever sought to take down the website of the Complainant;
 - The Complainant was under the impression until recently that the Domain Name belonged to it as the Respondent had been reimbursed all monies that she has paid on behalf of the Complainant for the continuation of the Domain Name since its inception;

- The continuation of the Domain Name for the next three years is a deliberate attempt to deny the continued use of the Domain Name by the Complainant. The Respondent has paid this latest renewal herself, whereas on every other occasion she has requested reimbursement from the Complainant;
- The Respondent has previously been willing to transfer the Domain Name to the Complainant. It has not until recently become clear that there has been an issue with regards to the transfer of this ownership. This seems to be bound up with the family dispute which involves the Respondent's partner who is also the father one of the owners of the Complainant.

5.14 The second half of the Reply deals directly with the Response and can be summarised as follows:

- The Complainant refutes the assertion that the Respondent intentionally registered the Domain Name for herself as since 2008 the Complainant has been using the Domain Name to trade and all e-mail web-related activity has been through the Domain Name. The Complainant acknowledges that all fees have been paid by the Respondent, but on each occasion the Respondent has been reimbursed the exact amount that was paid on behalf of the Complainant. The Complainant agrees that the Respondent has not been paid a fee for her services in renewing the Domain Name;
- The Domain Name has been exclusively used by the Complainant since its registration and the Complainant has paid for it by reimbursing the Respondent at each renewal. Accordingly, the Domain Name is an Abusive Registration within the meaning of Paragraph 5.1.5 of Nominet's Dispute Resolution Service Policy ("the Policy").

6. Discussions and Findings

6.1 Paragraph 2.1 of the Policy requires that the Complainant must prove, on the balance of probabilities, that:

2.1.1 The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and

2.1.2 The Domain Name, in the hands of the Respondent, is an Abusive Registration.

Rights

6.2 As a first step I must therefore decide whether the Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name.

6.3 The definition of Rights in the Policy is as follows:

Rights means rights enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning.

6.4 This has always been treated in decisions under Nominet's DRS as a test with a low threshold to overcome and I think that must be the correct approach.

6.5 The Complainant has not provided very much detail about its use of the name NORCIS. It has not, for example, provided examples of its advertising or marketing, nor has it provided breakdowns of the amount that it has spent on advertising or marketing. There is also limited information about the business of the Complainant other than references to the website at www.norcis.co.uk and screen shots showing that it has filed accounts for the last nine years.

6.6 It is however clear that the Complainant has traded under the name NORCIS for a number of years. It has a website which clearly and prominently uses the name NORCIS and it also uses letter heading which clearly bears the name NORCIS. Additionally, the word NORCIS figures prominently in all of the Complainant's e-mail addresses and the e-mail address enquiries at norcis.co.uk appears on the Complainant's letter heading.

6.7 I would also add that the word NORCIS is an acronym for Northern Control and Instrumentation Solutions which I understand describes the Complainant's business. The word NORCIS by itself is however not descriptive in any way other than its meaning as an acronym and it would appear to have a strong distinctive character.

6.8 Given all this it seems likely to me that the Complainant has built up reputation and goodwill through its use of NORCIS as described above. On this basis, I find that, on the balance of probabilities, the Complainant has Rights in the word or mark NORCIS.

6.9 The Domain Name differs only from the name NORCIS by the addition of the first and second level suffix, which I may ignore for the purposes of this assessment. I therefore conclude that the Complainant has Rights in a name or mark which is identical to the Domain Name.

Abusive Registration

6.10 Abusive Registration is defined in Paragraph 1 of the Policy as a domain name which either:

- i. was registered or otherwise acquired in a manner which, at the time when the registration or acquisition took place, took unfair advantage of or was unfairly detrimental to the Complainant's Rights; or*
- ii. is being or has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights.*

6.11 This definition requires me to consider whether the Domain Name is an Abusive Registration either at the time of registration/acquisition or subsequently through the use that was made of it.

6.12 Paragraph 5 of the Policy provides a non-exhaustive list of the factors which may constitute evidence that a Domain Name is an Abusive Registration and Paragraph 8 of the Policy provides a non-exhaustive list of the factors which may constitute evidence that the Domain Name is not an Abusive Registration.

6.13 The Policy requires the Complainant to prove, on the balance of probabilities, that the Domain Name is an Abusive Registration. The burden of proof is therefore firmly on the Complainant.

6.14 One of the factors that may be taken as evidence that the Domain Name is an Abusive Registration is set out in Paragraph 5.1.5 of the Policy. It reads as follows:

5.1.5 The Domain Name was registered as a result of a relationship between the Complainant and the Respondent, and the Complainant:

5.1.5.1 has been using the Domain Name registration exclusively, and

5.1.5.2 paid for the registration and/or renewal of the Domain Name registration.

6.15 There is therefore effectively a three stage test which the Complainant must satisfy if it is to bring itself within Paragraph 5.1.5. This is as follows:

1. Was the Domain Name registered as a result of a relationship between the Complainant and the Respondent?; and
2. Has the Complainant been using the Domain Name registration exclusively?; and
3. Has the Complainant has paid for the registration and/or renewal of the Domain Name registration?

I will therefore look at each stage of this test in turn.

6.16 Was the Domain Name registered as a result of a relationship between the Complainant and the Respondent? On the facts of this case there is clearly a relationship between the Respondent and the Complainant and it seems clear that the Domain Name was registered as a result of that relationship. The nature of that relationship appears to have been that the Respondent was providing

technical assistance to the Complainant as a computer literate person. I do think that it must matter whether as a result of that relationship the Respondent intended to register the Domain Name in her own name or in the name of the Complainant. What matters is that the Domain Name was registered by the Respondent as a result of a relationship between the parties and the first part of the test is satisfied.

- 6.17 Has the Complainant been using the Domain Name registration exclusively?** The Domain Name was registered five days after the Complainant was incorporated and there seems to be no serious dispute that it has always been used in relation to the Complainant's business both to point to the Complainant's website and as an e-mail address for the Complainant and its staff. The second part of the test is therefore satisfied.
- 6.18 Has the Complainant has paid for the registration and/or renewal of the Domain Name registration?** While the Respondent paid for the registration of the Domain Name and its renewal, the Complainant has always reimbursed the Respondent for those costs. The one exception to this is the most renewal by the Respondent for which the Respondent has not been reimbursed by the Claimant and as far as I can see the Respondent has not asked for those fees to be reimbursed.
- 6.19** Nominet's WHOIS record suggests that this most recent renewal was done fairly recently in January 2017 and therefore as it took place after this dispute had arisen, I am not inclined to take it into account. I think it is more relevant to take into account that, in the normal course of events, i.e. before the parties fell out, the Respondent would pay the fees for the Domain Name and the Complainant would reimburse them. I see no difference between that and the Complainant paying directly for the registration and renewal of the Domain Name. The third part of the test is therefore satisfied.
- 6.20** The Respondent also complains that she has never been paid for any of her work in relation to the Domain Name. That is of course a matter which I am not deciding on and I give no view either way as to whether the Respondent was entitled to be paid for that work.
- 6.21** The Complainant has satisfied all three stages of this test and accordingly, on the balance of probabilities, the Complainant has established a case for Abusive Registration under Paragraph 5.1.5 of the Policy as set out above.
- 6.22** Having made that finding, I must go on to look at whether there is anything that would persuade me that the Domain Name is not an Abusive Registration and this includes looking at the list of non-exhaustive factors which may evidence that the Domain Name is not an Abusive Registration which are set out in Paragraph 8 of the Policy. I have looked very carefully at the Response (as well as the Complaint and Reply) and I cannot see anything that would lead me to find that any of the circumstances which are described in Paragraph 8 of the Policy are made out or, indeed there is anything else that would lead me to find that this is not an Abusive Registration.

6.23 I should stress that my finding that the Domain Name is an Abusive Registration is a finding on the very narrow basis of Paragraph 5.1.5 of the Policy. I am not making a finding that the Domain Name is an Abusive Registration for any other reason, including those set out in any of the other paragraphs of Paragraph 5 of the Policy.

6.24 I should also say that it is clear from the documents that I have seen that at the heart of this Complaint is a family dispute which involves the owners of the Complainant on one hand and the Respondent and her partner on the other had. I have not had to consider the nature of this dispute for the purposes of making this decision and I do not give any view or finding in relation to that family dispute as part of this decision.

7. Decision

I find that the Complainant has Rights in a name or mark which is identical or similar to the Domain Name. I also find that, on the balance of probabilities, the Complainant has established that the Domain Name in the hands of the Respondent is an Abusive Registration. I therefore direct that the Domain Name should be transferred to the Complainant.

Signed ...Nick Phillips...

Dated